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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,684	03/30/2000	Larry D. Kinsman	3056.1US (96-803.1)	8722

7590 05/22/2006

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

3/2

<b>Office Action Summary</b>	Application No. 09/538,684	Applicant(s) KINSMAN ET AL.	
	Examiner David E. Graybill	Art Unit 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12, 14-29, 31-37 and 39-45 is/are pending in the application.
- 4a) Of the above claim(s) 7, 21, 23 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-12, 14-20, 22, 24-29, 31, 33-37 and 39-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 page</u> . | 6) <input type="checkbox"/> Other: _____  |

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6, 8-12, 14-20, 22, 24-29, 31, 33-37 and 39-45 are rejected under 35 U.S.C. 101 as being non-statutory because they improperly embrace or overlap two different statutory classes of invention, namely, device and process of using the device, which statutory classes are set forth only in the alternative in 35 U.S.C. 101.

Also claims 1-4, 6, 8-12, 14-20, 22, 24-29, 31, 33-37 and 39-45 are rejected under 35 U.S.C. 112, second paragraph, because they are directed to both a device and a process of using the device. As a result, the scope of the claims cannot be determined. See MPEP 2173.05(p)II.

Specifically, claims 1, 22, 24 and 25 are drawn to a device, yet the limitation, "leads having a reduced lead inductance," is a process of using the device. To further clarify, lead inductance is a property of the lead by which an electromotive force is induced in it by a variation of current either in the lead itself or in a neighboring lead. Therefore, when an electromotive force is not induced in the lead, i.e., when the lead is not in use, the leads cannot be having a reduced lead inductance.

Also, claim 1 is drawn to a device, yet the limitation, "the heat sink coupled to one of a signal voltage and a reference voltage, the heat sink operating respectively as a signal plane and a ground plane for the plurality

of leads of the lead frame reducing lead inductance of the plurality of leads of the lead frame," is a process of using the device. Claim 22 is drawn to a device, yet the limitation, "the heat sink and the integrated circuit die reducing lead inductance of the plurality of leads of the lead frame," is a process of using the device. Claim 24 is drawn to a device, yet the limitation, "the die attached surface being attached to the integrated circuit die reducing lead inductance of the plurality of leads of the lead frame," is a process of using the device. And, claim 25 is drawn to a device, yet the limitation, "the heat sink coupled to one of a signal voltage and a reference voltage for the heat sink to operate respectively as a signal plane and a ground plane for the plurality of the leads of the lead frame reducing lead inductance of the plurality of leads of the lead frame," is a process of using the device.

Claims 1-4, 6, 8-12, 14-20, 22, 24-29, 31, 33-37 and 39-45 have not been rejected over the prior art because, in light of the 35 U.S.C. 112 rejections *supra*, there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. Also see *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). See also MPEP 2143.03 and 2173.06.

Applicant's remarks filed 2-21-6 have been fully considered and are moot in view of the rejections supra.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. **For information on the status of this application applicant should check PAIR:** Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.**

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.  
The fax phone number for group 2800 is (571) 273-8300.

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A handwritten signature in black ink, appearing to read 'David E. Graybill'.

David E. Graybill  
Primary Examiner  
Art Unit 2822

D.G.

11-May-06